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Cofc

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/695,771
U.S. Patent No. : 7,021,142
Applicant : ROARK, Richard S.
Filed : October 30, 2003
TC/A.U. : 2855
Examiner : McCall, E.
Confirmation No. : 6891
Docket No. : 1814.0001C
Customer No. : 27896
Title : Mountable Sound Pressure Level Meter

Certificate

DEC 04 2006

of Correction

ATTN: Certificate of Correction Branch

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**REQUEST FOR RECONSIDERATION OF PREVIOUSLY SUBMITTED REQUEST FOR
CERTIFICATE OF CORRECTION UNDER 37 CFR 1.323
TO CORRECT ASSIGNEE'S NAME**

Sir:

Attached is a copy of a previously submitted Request for Certificate of Correction under 37 CFR 1.323 which erroneously has been rejected, together with copies of the accompanying papers filed with the Request including: a copy of the date-stamped filing receipt for the previously submitted Request for Correction dated September 13, 2006; a copy of the previously submitted Certificate of Correction; and a copy of the previously submitted check No. 9939 in the amount of \$230.00 for payment of the correction fee (\$100) and processing fee (\$130).

Attached is a copy of a communication from the USPTO dismissing the Request for Certification of Correction. This communication includes a number of incorrect statements in support of dismissing the Request.

First, it is alleged that a petition under 37 CFR 1.183 (a petition to suspend the rules) is required to correct assignee data. **This is not correct.** Correction of assignees' names is governed by 37 CFR 3.81(b) and MPEP 1481.01. For convenience, copies of both this rule and MPEP section are attached. As can be seen by reviewing this brief rule, there is simply no requirement in 37 CFR 3.81(b) or MPEP 1481.01 for *any* petition to correct an assignee's name on a patent, much less any requirement for a petition to suspend the rules under 37 CFR 1.183.

In any event, there is no need to suspend the rules when Rule 3.81(b) applies perfectly well in this circumstance. In short, it is respectfully submitted that the USPTO erred in requiring Applicant to submit a petition to suspend the rules in order to correct assignee's name on the patent, since there is already a rule for this procedure.

Second, it is alleged that applicant failed to meet certain requirements under 37 CFR 3.81(b)/MPEP 1481.01 (which is both contradictory and ironic, given that the Communication initially states assignee data cannot be corrected by a certification of correction and requires suspension of the rules, but then spells out the specific requirements of the rule which does indeed govern correction of assignee data by certificate of correction). Specifically it is alleged that Applicant failed to state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent (identified as item "A"), and that Applicant failed to pay the processing fee set forth in 37 CFR 1.17(i) (identified as item "C"). *These allegations also are incorrect.* In fact, Applicant quite plainly met both of these requirements, as can easily be seen by spending about 15 seconds reviewing the Request (which is attached for convenience).

Specifically, in the first paragraph of the Request, Applicant stated:

"An assignment from the inventor to Sabrina Roark was submitted for recordation in accordance with 37 CFR 3.11 before issuance of the patent, and the Assignment document was recorded in the USPTO on October 30, 2003, on reel 014659, frame 0625."

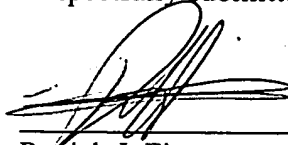
It is believed that this statement satisfies the requirement for "item A." Further, in the second paragraph of the Request, Applicant stated:

Enclosed herewith is a check in the amount of \$230 for payment of the \$100 certificate of correction filing fee under 37 CFR 1.20(a) and the \$130 processing fee under 37 CFR 1.17(i), as required by 37 CFR 3.81(b).

A copy of the previously submitted check for \$230 is also enclosed for convenience. It is believed that this statement and the accompanying statement satisfy the requirement for "item C" (as well as "item B"). Thus, Applicant's previously submitted Request meets all the requirements for correcting the assignee's name under 37 CFR 3.81(b), and there are no other requirements for having the assignee's name corrected. Notably, 37 CFR 3.81(b) does not include a requirement to file a petition to suspend itself.

In view of the foregoing, Applicant requests that the Certificate of Correction Branch properly process and grant the previously submitted Request for Certificate of Correction.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Patrick J. Finnan', is written over a horizontal line.

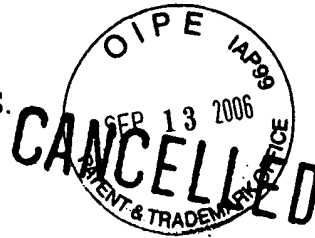
Patrick J. Finnan
Registration No. 39,189

Hand-delivered: November 30, 2006



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/695,771
U.S. Patent No. : 7,021,142
Applicant : ROARK, Richard S.
Filed : October 30, 2003
TC/A.U. : 2855
Examiner : McCall, E.
Confirmation No. : 6891
Docket No. : 1814.0001C
Customer No. : 27896
Title : Mountable Sound Pressure Level Meter



Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The stamp of the U.S. Patent and Trademark Office placed hereon will indicate the date of receipt of the following:

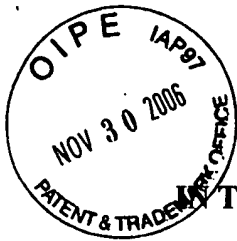
Request for Certificate of Correction (1 Page);

Certificate of Correction (1 Page); and

Check No. 9939 in the amount of \$230.00 for payment of the
correction fee (\$100) and processing fee (\$130).

Hand-delivered: September 13, 2006

PJF/pqv
✓
P2K
9/14/06



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/695,771
U.S. Patent No. : 7,021,142
Applicant : ROARK, Richard S.
Filed : October 30, 2003
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Docket No. : 1814.0001C
Customer No. : 27896
Title : Mountable Sound Pressure Level Meter

ATTN: Certificate of Correction Branch

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 CFR 1.323
TO CORRECT ASSIGNEE'S NAME

Sir:

Applicant hereby requests that the attached Certificate of Correction be issued for the above-identified patent to correct the Assignee's Name. An assignment from the inventor to Sabrina Roark was submitted for recordation in accordance with 37 CFR 3.11 before issuance of the patent, and the Assignment document was recorded in the USPTO on October 30, 2003, on reel 014659, frame 0625. Applicant erroneously omitted the Assignee information on the Issue Fee Transmittal Form upon payment of the issue fee.

Enclosed herewith is a check in the amount of \$230 for payment of the \$100 certificate of correction filing fee under 37 CFR 1.20(a) and the \$130 processing fee under 37 CFR 1.17(i), as required by 37 CFR 3.81(b). The Commissioner is hereby authorized to charge payment of any additional fees required for the above-identified application or credit any overpayment to Deposit Account No. 05-0460.

Respectfully submitted,

Patrick J. Finnan
Registration No. 39,189

Hand-delivered: September 13, 2006

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,021,142 B2
DATED : April 4, 2006
INVENTOR(S) : Roark

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

(73) Assignee:

Sabrina Nelson Roark, Clarksville, Tennessee

MAILING ADDRESS OF SENDER:

Edell, Shapiro & Finnan, LLC
1901 Research Blvd., Suite 400
Rockville, Maryland 20850

PATENT NO. 7,021,142 B2

No. of additional copies



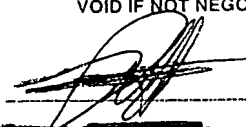




This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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EDELL, SHAPIRO & FINNAN, LLC PATENT & TRADEMARK OFFICE ACCOUNT 1901 RESEARCH BLVD., STE 400 ROCKVILLE, MD 20850		9939	
DATE <u>9/13/06</u>		65-233-550	
PAY TO THE ORDER OF	The Director of the US Patent and Trademark Office		
<u>Two Hundred & Thirty & 00/100</u>		\$ <u>230.00</u>	
 THE COLUMBIA BANK ROCKVILLE OFFICE ROCKVILLE, MD 20850		DOLLARS  <small>Security Features Indicated Details on Back</small>	
FOR <u>1814 00010</u>		VOID IF NOT NEGOTIATED WITHIN SIX MONTHS	
			
			



By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: 571-273-8300
ATTN: Office of Petitions

If a fee (currently \$100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Ernest C. White, *LIE*
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703)
308-9390 x 122 or (703) 305-8228

EDELL, SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE MD 20850

ecw

by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b)(1)(i) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005.]

ISSUANCE TO ASSIGNEE

§ 3.81 Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name of the assignee consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request must state that the document has been filed for recordation as set forth in § 3.11.

(b) *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17 (i) of this chapter.

(c) *Partial assignees.* (1) If one or more assignee, together with one or more inventor, holds the entire right, title, and interest in the application, the patent may issue in the names of the assignee and the inventor.

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

§ 3.85 Issue of registration to assignee.

The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document

arising as if the same had been originally issued in such corrected form.

37 CFR 1.323. Certificate of correction of applicant's mistake.

****>**The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.<

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 - § 1460). See *Novo Industries, L.P. v. Micro Molds Corporation*, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:

Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:

- (1) of a clerical nature,
- (2) of a typographical nature, or
- (3) a mistake of minor character.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:

- (1) constitute new matter or
- (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

The fee for providing a correction of applicant's mistake, other than inventorship, is set forth in 37 CFR 1.20(a). The fee for correction of inventorship in a patent is set forth in 37 CFR 1.20(b).

****>**

1481.01 Correction of Assignees' Names [R-3]

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The ****>**Fee(s)< Transmittal Form portion (PTOL-85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the ****>**Fee(s)< Transmittal Form PTOL-85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

****>**Any request for the issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee must:

(A) state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;

(B) include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and

(C) include the processing fee set forth in 37 CFR 1.17(i).

See 37 CFR 3.81(b).

1481.02 Correction of Inventors' Names [R-3]

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35 U.S.C. 256. Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and